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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,917	03/23/2005	Peter R Ebner	MAX 02.01CIP	9044
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HAYES SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718				
			EXAMINER	
			WOODALL, NICHOLAS W	
			ART UNIT	PAPER NUMBER
			3733	
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			07/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/528,917

Applicant(s)

EBNER, PETER R

Examiner

Nicholas Woodall

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,53,70,86,88,90-100,102 and 104-127 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,53,70,86,88,90-100,102,104-110 and 112-126 is/are rejected.
- 7) ☒ Claim(s) 111 and 127 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is in response to applicant's amendment received on 06/18/2007.

#### ***Allowable Subject Matter***

2. The indicated allowability of claims 53, 88, 89, 91, 96, 101, 103, 105, 106, 109, 110, and 112-126 is withdrawn in view of the newly discovered reference(s) to Ebner (U.S. Patent 6,755,837 B2) and Ebner (U.S. Patent 6,110,177). Rejections based on the newly cited reference(s) follow.

#### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 53, 86, 88, 90-100, 102, 104-110, and 112-126 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15, 17-22, 25, 26, and 53-69 of U.S. Patent No. 6,755,837 B2. Although the

conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1, 53, 86, 88, 90-100, 102, 104-110, and 112-126 of the application and claims 1-15, 17-22, 25, 26, and 53-69 of the patent lies in the fact that the patent claims include more elements and is more specific. Thus, the invention of claim 23 is in effect a "species" of the "generic" invention of claims 1, 53, 86, 88, 90-100, 102, 104-110, and 112-126. It has been held that the generic invention is "anticipates" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1, 53, 86, 88, 90-100, 102, 104-110, and 112-126 are anticipated by claims 1-15, 17-22, 25, 26, and 53-69 of the patent, they are not patentably distinct from claims 1-15, 17-22, 25, 26, and 53-69.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 127 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 53 states a limitation wherein the second end of the blade includes a pair of cantilever spring elements. Claim 127 states a limitation wherein the blade includes another pair of cantilever springs. There is not description of an embodiment of the device wherein the blade includes two pairs of cantilever springs.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 70, 93-95, 97-100, 104, and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altobelli (U.S. Patent 5,683,406) in view of Ebner (U.S. Patent 6,110,177).

Regarding claims 1 and 70, Altobelli discloses an instrument comprising a generally planar blade, a collection chamber with an upstanding retention member, and an elongated handle coupled to the end of the collection chamber as described in the previous office actions. Regarding claim 90, Altobelli discloses a device wherein the collection chamber comprises a mixing area as described in the previous office action. Regarding claim 97, Altobelli discloses a device wherein the blade comprises stainless steel (column 6 lines 25-26). Regarding claims 98-100, Altobelli discloses a device wherein the blade includes a pair of opposing lobes disposed adjacent a longitudinal slot as described in the previous office action. Regarding claim 104, Altobelli discloses a device comprising wherein the second end comprises a protrusion for facilitating extraction of the blade from the collection chamber as discussed in the previous office action. Regarding claim 108, Altobelli discloses a device wherein the sidewalls of the collection chamber support the first end of the blade in the instrument. Altobelli fails to disclose the blade member being a unitary member, it is noted that the Altobelli device

comprises several parts, i.e. the blade and blade cover, which are rigidly secured together as a single unit. Therefore, the constituent parts are so combined as to constitute a unitary whole or structure. In re Larson, 144 USPQ 347 (CCPA 1965).

Regarding claims 93-95, Altobelli discloses a device wherein the collection chamber is formed from a surgical grade material that is preferably in part transparent. Altobelli fails to disclose the material being stainless steel or a polymer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the device of Altobelli from stainless steel or a polymeric plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. The examiner believes it is further obvious to form the part from a surgical grade plastic material since the reference discloses a preferred embodiment wherein the chamber is at least partly transparent.

Further regarding claims 1 and 70, Altobelli fails to disclose the device wherein the second end of the blade has a stop mechanism. Ebner teaches a device comprising a blade having a second end further including a stop mechanism to prevent the blade from moving beyond the end of the device (column 5 lines 43-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Altobelli wherein the second of the blade has a stop mechanism in view of Ebner in order to prevent the blade from moving beyond the end of the device.

9. Claims 86 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altobelli (U.S. Patent 5,683,406) in view of Hutson (U.S. Patent 3,299,511).

Altobelli discloses the invention as claimed except for the handle portion being coupled to the collection chamber through a flexible joint. Hutson teaches of an assembly wherein an instrument is connected to a handle by means of a swivel joint in order to allow the operator to readily turn the instrument in any direction (column 1 lines 42-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Altobelli with a swivel joint between the handle and the collection chamber in view of Hutson in order to allow the operator to readily turn the instrument in any direction.

10. Claim 102 is rejected under 35 U.S.C. 103(a) as being unpatentable over Altobelli (U.S. Patent 5,683,406) in view of Wagner (U.S. Patent 6,099,311).

Regarding claim 102, Altobelli discloses the device as claimed except for the handle portion being coupled to the collection chamber through a ball and socket joint. Wagner teaches using a ball and socket connector between a handle portion and an instrument portion of a surgical device in order to attach the handle portion to the instrument portion of the device (column 3 lines 39-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Altobelli with a ball and socket connector between the handle portion and the collection chamber in view of Wagner in order to attach the handle portion to the collection chamber.

***Allowable Subject Matter***

11. Claims 111 and 127 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

12. Applicant's arguments with respect to claims 1 and 70 have been considered but are moot in view of the new ground(s) of rejection. The examiner has presented new grounds of rejection as discussed above. Since the examiner has withdrawn previously indicated allowability of claims as discussed above this office action is non-final.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



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